



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,940	10/18/2000	Dean F. Boyer	OHB-0047	5015

7590 11/22/2004

Troy J. Cole, Esq.  
Woodard, Emhardt, Naughton, Moriarty & McNett  
Bank One Tower/Cemter  
111 Monument Circle, Suite 3700  
Indianapolis, IN 46204-5137

EXAMINER

SHAH, ANKEETA

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/690,940

**Applicant(s)**

BOYER ET AL. S

**Examiner**

Ankeeta Shah

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/26/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/27/1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Claims 1- 23 have been cancelled.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 24 – 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6,8 and 11-13 of U.S. Patent No. 6,208,973. Although the conflicting claims are not identical, they are not patentably distinct from each other.

**Re Claim 24:** The difference between the pending claim and the patented claim 1 is that claim 24 discusses "covered portion" whereas claim 1 discusses "first portion" and "second portion".

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re Claim 25:** The difference between the pending claim and the patented claim 6 is that claim 25 discusses the point of service terminal is located in a pharmacy whereas claim 6 discusses that the point of service provider is a healthcare provider.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re Claim 26:** The difference between the pending claim and the patented claim 6 is that claim 26 discusses the point of service terminal is located in a physician office whereas claim 6 discusses that the point of service provider is a healthcare provider.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re Claim 27:** The difference between the pending claim and the patented claim 5 is that claim 27 discusses the purchase transaction includes a product identifier.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

Art Unit: 3628

**Re Claim 28:** The difference between the pending claim and the patented claim 5 is that claim 28 discusses the covered portion whereas claim 5 discusses the first portion. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 29:** The difference between the pending claim and the patented claim 1 is that the term "said purchase which is to be paid by the customer" is used instead of "copayment".

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 30:** The claim is identical as the patented claim 2.

**Re claim 31:** The difference between the pending claim and the patented claim 3 is that the term "covered portion" is used instead of "first portion".

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 32:** The claim is identical as the patented claim 4.

**Re claim 33:** The difference between the pending claim and the patented claim 1 is that the system calculates a non-covered portion (i.e. the portion "to be paid by the customer", claim 1) that is to be paid by the customer

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 34:** The difference between the pending claim and the patented claim 1 is that claim 1 discusses a payment system that charges the payment system card for at least second portion (i.e. paid by customer, i.e. non-covered) and point if service provider is paid second portion.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 35:** The difference between the pending claim and the patented claims 1 and 4 is that claim 1 discusses a payment system that charges the payment system card for at least second portion (i.e. paid by customer, i.e. non-covered) and point if service provider is paid second portion. Claim 4 discusses payment system includes a credit card.

Art Unit: 3628

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claims.

**Re claim 36:** The differences between the pending claim and the patented claim 8 are: claim 36 discusses "covered portion" whereas claim 8 discusses "first portion" and "second portion".

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 37:** The difference between the pending claim and the patented claim 6 is that claim 37 discusses the point of service provider is a pharmacy whereas claim 6 discusses that the point of service provider is a healthcare provider.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 38:** The difference between the pending claim and the patented claim 6 is that claim 38 discusses the point of service provider is a physician whereas claim 6 discusses that the point of service provider is a healthcare provider.

Art Unit: 3628

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 39:** The difference between the pending claim and the patented claim 13 is that claim 39 discusses the purchase transaction includes a product identifier whereas claim 13 discusses the purchase transaction includes a product identifier.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 40:** The difference between the pending claim and the patented claim 13 is claim 40 discusses "covered portion" (i.e. the amount that is to be paid by the third party) whereas claim 13 discusses "first portion"

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 41:** The difference between the pending claim and the patented claim 8 is that the term "said purchase which is to be paid by the customer" is used instead of "copayment".



Art Unit: 3628

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 42:** The claim is identical as the patented claim 11.

**Re claim 43:** The difference between the pending claim and the patented claim 3 is that claim 43 discusses the method whereas claim 3 discusses the system.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 44:** The difference between the pending claim and the patented claim 12 is that claim 12 discusses the adjudicated settlement transactions.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 45:** The difference between the pending claim and the patented claim 8 is that the system calculates a non-covered portion (i.e. the portion "to be paid by the customer", claim 1) that is to be paid by the customer.

Art Unit: 3628

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 46:** The difference between the pending claim and the patented claim 8 is that claim 8 discusses a payment system that charges the payment system card for at least second portion (i.e. paid by customer, i.e. non-covered) and point if service provider is paid second portion.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Re claim 47:** The difference between the pending claim and the patented claim 8 and 12 is that claim 8 discusses a payment system that charges the payment system card for at least second portion (i.e. paid by customer, i.e. non-covered) and point if service provider is paid second portion. Claim 12 discusses payment system includes a credit card.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the rejected claim is fully covered by patented claim.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankeeta Shah whose telephone number is (703) 305-0853. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG SOUGH can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600